

Application No. 09/858,385
Amendment dated November 29, 2006
Reply to Office Action of August 17, 2006

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REMARKS

The Applicant has now had an opportunity to carefully consider the remarks presented in the Office Action mailed August 17, 2006. Reexamination and reconsideration of the application are respectfully requested. Claims 1-11, 36 and 37 remain in the application. Claims 12-35 have been canceled.

The Office Action

Claims 1, 2 and 8-11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Tonkin (U.S. Patent Application 2005/0015392) in view of Takeda (U.S. Patent No. 5,485,282).

Claims 3-7 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Tonkin, in view of Takeda, and further in view of Yankovich (U.S. Patent No. 6,704,906).

Claims 36-37 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Tonkin in view of Takeda, in further view of Simpson (U.S. Patent No. 6,559,965) and Matsuo (U.S. Patent No. 6,775,729).

Interview of 10/4/2006

On October 4, 2006, Applicants conducted a telephone interview with Examiner Ries and Primary Examiner Bashore. In this interview, the Applicant and the Examiners agreed on additional claim language that helps to more clearly define over the Takeda reference. This additional claim language has been previously submitted for review by Examiner Ries and was determined to raise new issues that would require additional searching. Resultantly, the additional claim language discussed on October 4, 2006 is not included in the present Amendment.

The Current Amendments

The current amendments to claim 1 do not raise new issues that will require additional searching or consideration. The Applicant makes the changes to more clearly indicate the process of claim 1, but they were already inherent in the claim. Specifically,

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elements a) through d) relate to document creation, thus they are included under the header "creating a document." Similarly, elements e), f), and g) relate to submitting a document for printing and finishing, thus, they are included under the heading of "submitting a document for printing and finishing". These headers were already inherent in the claim, and thus do not require additional searching. The only serve to more clearly distinguish the sub-parts of claim 1.

The Takeda Reference

Takeda describes several situations of communicating fax machines. The idea of Takeda is to get an intelligible document from the receiving fax machine even though it is not configured the same way as the sending fax machine. When the sending fax machine is being used, a document is read by a reader 6, stored in a memory 7 then analyzed by an identifier 9. This identification informs the sending fax machine the size of the paper being used. This is then communicated to the receiving fax machine so that it will know on which type of paper to print the received document. If the receiving machine is capable of printing the size image that the sending machine is about to send, it reports that to the sending machine, and the document is sent. This process encompasses embodiments 1 and 2 of Takeda and assumes that both the sender and receiver have table 100 or 200.

In the third embodiment, Takeda assumes that the receiving fax machine is incapable of printing the desired size. The sending fax machine tells the receiving machine the size of the paper. The receiver responds with a NSC (non-standard capability) message stating that it cannot print that paper size. The sending machine then changes the paper size to one the receiver can accommodate. (See col. 6, lines 35-43, col. 6, lines 58-59, and FIG. 7, steps S20, S21) In the fourth embodiment, the sending machine forces the receiving machine to add the paper size to its list of capabilities.

Finally, in the fifth embodiment, the Sending machine picks a size that the receiving machine can accommodate. The difference between embodiments 3 + 4 and 5 is that the receiver picks the size in 3 and 4, and the sender picks the size in the fifth embodiment.

Takeda is about accommodation. If the receiving fax machine cannot handle a

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certain paper size, then Takeda changes the transmission to a size it can handle.

The Claims Distinguish over the References of Record

Claim 1 calls for mapping all generic document forms that result in the creation of a finished document and selecting one of a set of document forms that conforms to permanent, temporary, and capability restraints of printers and finishers that will print and finish the document. The combination of Tonkin and Takada does not teach these limitations. The combination of Tonkin and Takada does not reasonably suggest these limitations.

First, Tonkin does not disclose mapping all generic document forms and selecting one of a set of document forms that conforms to the permanent, temporary, and capability constraints of the printers and finishers to apply to a document. (Office Action, 8/17/2006, page 4, fourth paragraph) Since Tonkin fails to disclose these limitations, discussion will be limited to the Takada reference.

The Takada reference fails to teach mapping all generic document forms that result in the creation of a finished document. A "document form," as defined by the Applicant, is "the manner in which the various components are finished into a composite form, including such operations as folding, cutting, stitching, binding, and gluing. Each document form requires unique image imposition, printing, finishing process requirements and physical identifying characteristics." (Applicant's original specification, page 15, second full paragraph) This is how the Applicant has defined a term, and that term is used in the claim. Thus, the definition given must be imported into the claim.

Claim terms are first and foremost interpreted in light of how they are defined in the specification. Normally, during examination, claims are to be interpreted as broadly as their terms reasonably allow. If, however, a claim term is given a clear definition in the specification, the claim term is interpreted in light of the specification. (MPEP 2111.01) ("words of the claim must be given their plain meaning unless applicant has provided a clear definition in the specification") If the specification provides definitions for terms appearing in the claims then the specification can be used in interpreting claim language.

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Id. In the Applicant's specification, the term "document form" is in quotation marks, followed by "shall refer to..." Since the definition of "document form" is clearly defined in the specification, the claim language "mapping all generic document forms" must be interpreted as it is defined in the Applicant's specification.

Takada discloses deciding paper size. Takada does not disclose anything that discusses document forms, as defined by the Applicant. At col. 5, lines 20-37, Takada mentions document types, and paper sizes in corresponding form, but it is all in relation to the size of the paper. Table 100 is a table of paper names and dimensions. Table 200 is a table of paper names and dimensions that are assigned numbers. Nowhere does Takada disclose operations such as folding, cutting, stitching, binding, and gluing; Takada only considers paper size. Takada neither maps document forms, nor selects a document form that conforms to restraints of printers and finishers. Since "document form," as defined by the Applicant, is more inclusive than strictly paper size, the Takada reference fails to teach or reasonably suggest limitations e) and f) of claim 1. Thus, since neither Tonkin nor Takada teach these limitations, it is respectfully submitted that **claim 1, and claims 2-11, 36, and 37** dependent therefrom distinguish patentably and unobviously over the references of record.

The following arguments were submitted with the October 11 After Final Amendment. No indication was given by the Examiner whether or not they were considered, and so they are provided here for the Examiner's convenience. The following arguments do not concern the proposed amendments submitted in the October 11 After Final Amendment, that is, they concern claim language being properly presently considered by the Office.

As previously discussed, Takeda changes the transmission size of the fax so that the receiving fax machine can print it out. The present application, in contrast routes the job to printers and finishers that can handle the job; it does not change the parameters of the job like Takeda does. **Claim 1** calls for selecting one of a set of document forms that

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conforms to the permanent, temporary, and capability restraints of the printers and finishers. ("Document form" is defined on page 15 of the original specification.) In other words, if a certain document creation form will not result in the creation of a desired document, the present application picks a different form that will. The combination of Tonkin and Takeda, in contrast, does not select a new form, that is, Takeda does not select a new path. Takeda changes the job, instead of changing the path.

To illustrate, imagine that a job is to be printed on A4 paper. Printer A is out of A4 paper (a temporary constraint). The present application would choose a path (form) that does not involve printer A. Instead, the present application would send the job to printer B, which has A4 paper. The combination of Tonkin and Takeda, in contrast, upon discovering that Printer A is out of A4 paper, would instruct Printer A to print the job on 8½ by 11 paper. Takeda settles for something that the receiving machine can do, rather than choosing a path of machines that can perform the job as ordered. Thus, it is respectfully submitted that **claim 1**, as well as **claims 2-11, 36, and 37** distinguish patentably and unobviously over the references of record.

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CONCLUSION

For the reasons detailed above, it is respectfully submitted all claims remaining in the application (Claims 1-11, 36 and 37) are now in condition for allowance. In the event that the Examiner considers personal contact advantageous to the disposition of this case, she should feel free to call Patrick R. Roche, at telephone number (216) 861-5582.

Respectfully submitted,

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11/30/06
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